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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/759,829 | 01/12/2001 | Stuart Berkowitz | 668437600002 | 1904 |

24739 7590 02/23/2007

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| EXAMINER | |
|---|---|
| RETTA, YEHDEGA | |
| ART UNIT | PAPER NUMBER |
| 3622 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 02/23/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/759,829 | BERKOWITZ ET AL. | |
| | Examiner | Art Unit | |
| | Yehdega Retta | 3622 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *22 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-8 and 11-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8 and 11-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

This office action is in response to amendment filed November 22, 2006. Applicant amended claims 1 and 14. Claims 1-8 and 11-28 are currently pending.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Saylor et al. (US 6,707,889).

Regarding claim 14, Saylor teaches a database that stores audio advertising data (see col. 7 lines 3-59);

an advertising retrieval server with a data connection to the database, wherein the advertising retrieval server retrieves audio advertising data based upon predetermined selection rules; and a network port with a connection to the advertising retrieval server and to the network, wherein the network port provides a data communication pathway so that an advertisement may be played over the network to the users of the telephony services based upon the retrieved audio advertising data; wherein a caller places a call to a telephony server and the telephony server is used to access a service that is located on the network, wherein the advertising retrieval server provides the service and the advertisement to the user(see col. 7 lines 35-51, col. 27 lines 37-60, col. 36 line 54 to col. 37 line 8):

wherein the service is a voice markup language application located on the Interact (col. 8 lines 17-40, col. 14 lines 48-64, col. 21 lines 9-44).

Regarding claims 15-22, Saylor teaches the audio advertising data is an audio file containing the advertisement (col. 7 lines 35-50); wherein the audio advertising data includes a location identifier to locate an audio file on the network; wherein the network is an Internet network; wherein the location identifier is a Uniform Resource Location (URL) that identifies on a remote computer on the Internet network an audio file containing the advertisement to be played (col. 8 line 18 to col. 9 line 63, col. 11 lines 47-56); wherein a request is provided to the advertising retrieval server to provide the advertisement to the users of the telephony services; wherein the request includes a user profile, wherein the advertising retrieval server retrieves stored audio advertising data from the database that substantially matches the user profile provided in the request; wherein the selection rules include balanced ad usage rules that are used to determine which stored audio advertising data to retrieve; the selection rules include profit rules that are used to determine which stored audio advertising data to retrieve (see col. 7 lines 35-66, col. 27 lines 36-60, col. 36 line 53 to col. 37 line 27).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8 and 11-13 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saylor et al. (US 6,707,889) further in view of Eldering (US 6,324,519).

Regarding claims 1-4, Saylor teaches users placing a call to telephony server to access a service located on the network (VNAP); making the call free to encourage users to call. Saylor teaches one or more Vpages containing advertisements that are delivered to a user's phone (e.g., a voice ad), the Vadvertisement comprising a portion or a complete VPage that advertises a product or service using voice which provide the user with the option to purchase a good or service during the interface (see col. 7 lines 35-51, col. 27 lines 37-60, col. 36 line 54 to col. 37 line 8). Saylor teaches the VAd may be selected based on the content requested by the user. Further providers of VAds may be charged to have that VAd referenced or included in a Vpage and the VAd may be played for each or selected users upon accessing the VNAP central number or at other times. Saylor teaches the charge may be a flat fee for a period of time, a fee for each user for whom the VAd is played or otherwise (see col. 7 lines 8-51). Saylor however failed to teach receiving bid data from advertisement providers wherein an audio advertisement is played over the network if the bid data is determined satisfactory, it is taught in Eldering. Eldering teaches receiving bids data from advertisement providers over a network, wherein an audio advertisement (see col. 1 lines 37-56, col. 4 lines 7-11) is played over the network if a bid data is determined satisfactory, receiving asking data over the network to determine whether the bid data is satisfactory (see col. 10 lines 29-64); determining whether the bid data is satisfactory and storing and playing an audio advertisement after the bid data is determined satisfactory (see abstract, col. 1 lines 37-56, col. 3 lines 1-55, col. 11 lines 37-47). Eldering teaches this can also occur when the content/opportunity provider is also the cable operator or telephone company, and in such instances, the cable operator or telephone company can be providing content to consumer over the cable operator/telephone company access network. As an example, if the

cable operator has control over the content being transmitted to the consumer 100, and has programmed times for the insertion of advertisements, the cable operator is considered to be a content/opportunity provider 160 since the cable operator can provide advertisers the opportunity to access consumer by inserting an advertisement at the commercial break. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use Eldering's bidding system to select an advertisement in Saylor's VAd based on the highest bidder as in Eldering in order to maximize the profit.

Regarding claims 5-8, 11-13, Saylor teaches storing a plurality of audio advertisements in a database; receiving a request to retrieve at least one of advertisements based upon predetermined selection rules; based on user profile; based on ad usage rules; based on profit rules (see col. 7 lines 35-51, col. 27 lines 37-60, col. 36 line 54 to col. 37 line 8); wherein the advertisement is played over the network to users of the telephony services; wherein the service is a voice markup language application located on the Internet (col. 8 lines 17-40, col. 14 lines 48-64, col. 21 lines 9-44).

Regarding claims 23-26 Saylor teaches the VAd may be selected based on the content requested by the user. Further providers of VAds may be charged to have that VAd referenced or included in a Vpage and the VAd may be played for each or selected users upon accessing the VNAP central number or at other times. Saylor teaches the charge may be a flat fee for a period of time, a fee for each user for whom the VAd is played or otherwise (see col. 7 lines 8-51). Saylor does not teach advertising management server receives bid data from advertisement providers over the network, wherein the audio advertisement is played over the network if the bid data is determined satisfactory; receives asking data over the network to determine whether

the bid data is satisfactory; wherein the bid data is satisfactory based upon a comparison between the bid data and the asking data; wherein ad usage data is collected about the playing of the advertisement to the users, wherein the asking data is formulated based upon the ad usage data. Eldering teaches receiving bids data from advertisement providers over a network, wherein an audio advertisement (see col. 1 lines 37-56, col. 4 lines 7-11) is played over the network if a bid data is determined satisfactory, receiving asking data over the network to determine whether the bid data is satisfactory (see col. 10 lines 29-64); determining whether the bid data is satisfactory and storing and playing an audio advertisement after the bid data is determined satisfactory (see abstract, col. 1 lines 37-56, col. 3 lines 1-55, col. 11 lines 37-47). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use Eldering's bidding system to select an advertisement in Saylor's VAd based on the highest bidder as in Eldering in order to maximize the profit.

Regarding claims 27 and 28, Saylor teaches wherein the advertising management server and the advertising retrieval server operate upon the same computer; wherein the advertising management server and the advertising retrieval server operate upon different computers (see fig. 1 and 2).

***Response to Arguments***

Applicant's arguments with respect to claims 1-8 and 11-28 have been considered but are moot in view of the new ground(s) of rejection. As indicated above Saylor teaches user placing a call to a telephone service to access service, same as applicant's invention. Eldering teaches receiving bid from advertiser and placing the ad with the highest bid.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

RETTA YEHDEGA
PRIMARY EXAMINER